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EXAMINER

ORWIG, KEVIN S

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,699	<b>Applicant(s)</b> ILEKTI ET AL.	
	<b>Examiner</b> Kevin S. Orwig	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Dec. 3, 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 78-167 is/are pending in the application.
- 4a) Of the above claim(s) 87,95-97,111-128,136-147 and 160-167 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 78-86,88-94,98-110,129-135 and 148-159 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/18/06, 12/20/07</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

Claims 78-167 are currently pending. Claims 78-86, 88-94, 98-110, 129-135, and 148-159 are the subject of this Office Action. This is the first Office Action on the merits of the claims. Non-elected claims 87, 95-97, 111-128, 136-147 and 160-167 are withdrawn from consideration.

### ***Election/Restrictions***

Applicants' election with traverse of Group I (claims 78-159) in the reply filed on Jun. 2, 2008 is acknowledged. The traversal is on the ground(s) that the Groups of the instant invention allegedly share common special technical features. This traversal is not found to be persuasive because there are three inventions, one drawn to a nail varnish composition, one drawn to a cosmetic assembly, and one drawn to a cosmetic process. Groups I and II are drawn to a different statutory category of invention (a composition of matter) than Group III, which is drawn to a method. The inventions are not so closely related as to depend absolutely upon one another and are therefore patentably distinct.

Applicants allege that the Groups (I-III) share common special technical features, but do not specifically point out what the common technical features are. Applicants argue that Morrissey does not read on the instant claims, but do not specifically point out how Morrissey fails to do so. As pointed out in the restriction requirement dated May 1, 2008, the common technical feature between the groups is a nail varnish

Art Unit: 1611

composition, which is not a contribution over the art as set forth in the restriction requirement. Since no further arguments have been presented by applicants at this time, the traversal is not persuasive for the withdrawal of the restriction requirement. The requirement is still deemed proper and is therefore made FINAL.

In the reply of Jun 2, 2008, applicants elected the following species:

Monomer structures: methyl methacrylate and methyl acrylate

Additional monomer: acrylic acid

Organic solvent medium: butyl acetate

In response to applicants' election, Group II (claims 160-166), and Group III (claim 167) are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on Jun. 2, 2008. Applicants have stated that claims 78-86, 88-94, 98-110, 129-135, and 148-159 read on the elected species.

### ***Information Disclosure Statement***

References lined-through on the information disclosure statement(s) were not considered because they were not provided or were not provided in English.

### ***Abstract***

The abstract of the disclosure is objected to because the abstract does not conform to current USPTO guidelines for the preparation of patent abstracts. While the current abstract is acceptable in its general content, the abstract contains legal

Art Unit: 1611

phraseology (i.e. "said composition") and contains more than one paragraph. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

A new abstract (150 words or less) is required that is sufficiently detailed as to provide general information about the precise nature of the invention to which the claims are directed. New matter is not permitted in the revised abstract. Correction is required. See MPEP § 608.01(b).

### ***Specification***

The specification is objected to because there is currently no claim for a priority benefit on the first line of the specification. It is noted that this application appears to claim subject matter disclosed in prior Application No. PCT/FR03/02846, filed Sep. 26, 2003. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if

Art Unit: 1611

applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that

Art Unit: 1611

the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

***Claim Rejections - 35 USC § 112 (2<sup>nd</sup> Paragraph)***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 78-86, 88-94, 98-110, 129-135, and 148-159 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Art Unit: 1611

Claims 78-86, 88-94, 98-110, 129-135, and 148-159 are indefinite in the recitation of "...the mean gloss at 20°..." in claims 78, 156, and 157 as well as the similar limitation of "...the mean gloss at 60°..." in claims 158 and 159. The units of degrees are undefined. Is this limitation a temperature? If so, is it in units of °C, °F, °K or some other temperature scale? Alternatively, this limitation could be referring to an angle. This term is not defined by the claim, the specification does not provide a sufficient standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is noted that the portion of the specification dealing with the term "mean gloss" does not correct this ambiguity. For example paragraph [0022] states that the deposit is left to dry for 24 hours at a temperature of 30° C., and the gloss at 20° is then measured. It is noted that measurement of "mean gloss" in this way is not an industry standard. As such it would not be readily apparent to one of ordinary skill in the art that the recitation of 20° is intended to be a temperature. Thus, one of ordinary skill in the art would not know how the mean gloss must be measured to meet this limitation. Since one of ordinary skill in the art could not be expected to make a reasonable distinction in the absence of further definitions and/or guidance in the specification, the metes and bounds of these claims are indefinite.



If applicants contend that the recitation of 20° is intended to be, for example, a temperature, applicants must show that one skilled in the art would have understood that this choice, and not another, was surely intended.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 78, 81-84, 88, 98, 148-150, 152, and 153 are rejected under 35 U.S.C. 102(b) as being anticipated by MOUGIN (U.S. 2002/0115780; Published Aug. 22, 2002; Reference #7 on IDS dated Jul. 18, 2006).**

1. Mougin discloses film-forming block ethylenic copolymers for use in cosmetics (abstract). Mougin teaches that a preferred embodiment of the cosmetic composition is as a nail varnish, and the compositions comprise a cosmetically acceptable organic solvent medium such as butyl acetate (elected species) (paragraphs [0012], [0099], [0100], and [0131]; Example 4; claim 31). Mougin also teaches that the use of the inventive copolymers in nail varnishes increases the impact strength of nail varnishes

Art Unit: 1611

and improves staying power without causing user discomfort (paragraphs [0007]).

Mougin does not use nitrocellulose in the compositions (i.e. they are nitrocellulose free).

2. The block copolymers taught by Mougin comprise at least one rigid block having a glass transition temperature ( $T_g$ ) greater than or equal to 20°C and at least one flexible block having a  $T_g$  of less than 20°C (abstract; claim 1). Furthermore, Mougin teaches ethylenic monomers for use in the blocks of the copolymer that are substantially identical to those claimed in the instant application. For example preferred monomers for the rigid blocks include methyl methacrylate (elected species) (paragraphs [0070] and [0082]; claims 3 and 14) and methyl acrylate (elected species) (paragraph [0084]; claims 4 and 15). The number average molar mass for the polymers exemplified by Mougin is 51,900 and the weight-average molar mass is 114,500 (paragraph [0143]).

3. Mougin does not disclose the mean gloss of the compositions. However, it is noted that Mougin teaches monomers for use in the blocks of the copolymer that are identical to those claimed in the instant application (paragraphs [0047]-[0097]). Since the nail varnish compositions of Mougin are glossy and provide high transfer resistance (i.e. staying power and wear resistance), just as those in the instant specification, it is reasonable that the cosmetic compositions taught by Mougin (e.g. Example 4) would meet the limitations of mean gloss and transfer index if measured under the highly specialized conditions required in claim 78. Furthermore, the claim only requires that the mean gloss of a deposit (of unspecified dimensions) be greater than or equal to 50 out of 100 *when present in a sufficient amount*. The compositions of Mougin are taught

Art Unit: 1611

in a preferred embodiment as glossy nail varnishes (e.g. example 4), which are typically prepared for the very purpose of having a glossy or shiny finish. Thus, it is the examiner's position that the compositions taught by Mougin would have a mean gloss that meets the instant limitation and would be formulated as such by the ordinary artisan per the object of Mougin's invention.

4. The U.S. Patent Office is not equipped with analytical instruments to test prior art compositions for the infinite number of ways that a subsequent applicant may present previously unmeasured characteristics. When, as here, the prior art appears to contain the exact same ingredients and applicant's own disclosure supports the suitability of the prior art composition as the inventive composition component, the burden is properly shifted to applicant to show otherwise.

5. Therefore, Mougin anticipates claims 78, 81, 82, 84, 88, 98, 148, and 149. Regarding claim 149, applicants have elected butyl acetate as the species of organic solvent and have stated that claim 149 reads on this species. Thus, butyl acetate must have a polarity ranging from 0.422 to 0.725 or the species does not read on the claim and it should have been withdrawn from consideration. Mougin teaches that the block ethylenic copolymers may be diblock or triblock polymers having various configurations of the blocks (paragraphs [0040]-[0043]). Even in the most simple diblock configuration (...ABABABAB...), the polymers comprise first and second blocks that are linked together via an intermediate segment comprising constituent monomers for the first and second blocks (for example, the underlined segment in the example above is such an intermediate segment), reading on claim 83. Mougin does not disclose a suitable

Art Unit: 1611

weight % range in which the solvent component can be included in the composition, but exemplifies one embodiment having 75% of the solvent (Example 4). Thus, Mougin reads on claim 150. Mougin teaches the use of pigments (i.e. dyestuffs) in the composition in a preferable weight % range from 8-10% (paragraph [0123]), reading on claims 152 and 153.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 1611

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 78-80 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mougin.**

6. The teachings of Mougin are presented *supra*. It is noted that Mougin does not describe the polymers of the invention as elastomeric, but does teach that they have elastic character. Non-elastomeric polymers were defined in the instant specification as polymers with an instantaneous recovery  $R_i$  of <50% (paragraph [0036]). Mougin teaches that the polymers of the invention have an  $R_i$  between 5% and 100% (abstract; claim 1). Mougin teaches that the value of  $R_i$  depends on many factors such as the nature, number, and relative proportion of the rigid and flexible blocks or alternatively the molar mass of the polymer. The weight-average molar mass for the polymer exemplified by Mougin is 114,500 (paragraph [0143]), which is within the preferred range of 40,000 to 150,000 disclosed in paragraph [0077] of the instant application. Furthermore, Mougin teaches that the polymers may comprise applicants' elected monomer species, and allows for the same configuration of blocks as that instantly claimed. Since Mougin expressly teaches that the  $R_i$  may be below 50% it would be obvious to an ordinary artisan to formulate the polymers of Mougin in this range, and they are therefore non-elastomeric as defined in the instant application. Mougin renders claim 79 obvious. Mougin teaches styrene as an optional component of the polymers, but discloses styrene-free embodiments, rendering claim 80 obvious. Mougin teaches

Art Unit: 1611

that the rigid and flexible blocks must be immiscible and incompatible (paragraph [0031]; claim 8), rendering claim 86 obvious.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, in the absence of evidence to the contrary, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

**Claims 84, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mougin as applied to claims 78-80 and 86, and further in view of GALLEGUILLOS (U.S. 6,410,005; Issued Jun. 25, 2002).**

7. The teachings of Mougin are presented *supra*. The block copolymers taught by Mougin comprise at least one rigid block having a glass transition temperature ( $T_g$ ) greater than or equal to 20°C and at least one flexible block having a  $T_g$  of less than 20°C (abstract; claim 1). Mougin teaches that the block ethylenic copolymers may be diblock or triblock polymers having various configurations of the blocks (paragraphs [0040]-[0043]). In particular, each block may consist of one or more different monomers (i.e. they may be homopolymers or random or alternating copolymers) and the blocks

Art Unit: 1611

used in the polyblock configurations may comprise the same or different polymers (paragraphs [0038] and [0043]). Thus, Mougin provides for the configuration wherein, for example, homopolymeric blocks A and B are connected by another (intermediate) block comprising monomers from A and B. Furthermore, such configurations were known in the art at the time of the invention.

8. For example, Galleguillos discloses AB block copolymers for cosmetic use on keratin substrates such as nails (col. 1, lines 12-14; col. 13, lines 27-29) comprising soft hydrophobic and hard hydrophilic blocks with two or more distinct glass transition temperatures, represented by Structures 1 and 2 (column 4, lines 44-65). Galleguillos teaches the preferred use of methyl methacrylate, methyl acrylate, and acrylic acid (all elected species) in the copolymers (col. 8, lines 32-33 and 63-67; col. 11, line 27). Specifically, Galleguillos discloses a process of polymerizing a polyfunctional monomer X within the scope of the instant intermediate block constituent (see column 4, structures 1 and 2) with a first ethylenically unsaturated monomer(s) to form an A block, and subsequently polymerizing a second ethylenically unsaturated monomer(s) containing at least one carboxylic acid group with the A block to form a B block, and the resultant block copolymer (column 3, lines 53-60; column 4, lines 18-43; column 5, lines 2-4; column 6, line 27 to column 7, line 57). Thus, a copolymer containing blocks of  $-(B)_p-X-(B)_q-$ , and  $-(A)_n-A-X-A-(A)_n-$  is formed, wherein X is a multifunctional monomer that links the A and B blocks. The linkage of X-X reads on the instant intermediate block, wherein X is also a constituent monomer of the A and B blocks in  $-(B)_p-X-(B)_q-$ , and  $-(A)_n-A-X-A-(A)_n-$ . Absent of specific compositional and architectural details

Art Unit: 1611

claimed for the instant intermediate block, prior art -B-X-X-A- linkages in structures 1 and 2 fall within the scope of the instant intermediate block as both blocks A and B contain at least one constituent X, as defined in the present claims.

9. Galleguillos teaches the weight percent of each of the monomers in the mixture can vary, depending on the desired properties of the final copolymer product and teaches that these properties can be tailored by varying the composition and length of the blocks (column 4, lines 38-39; column 13, lines 1-2). Galleguillos specifically discloses using varying proportion of mixtures of A and B monomers so as to achieve the desired balance of the resultant block polymer properties (column 12, lines 12-15; column 13, lines 1-8).

10. In light of these teachings, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to prepare a polymer arranged with a first block and a second block connected by an intermediate block comprising both types of monomers, to provide a suitable polymer compound. One would have been motivated to do so since the teaching of Mougin allows for and suggests such an arrangement, and since one of ordinary skill in the art would recognize that including a block comprising monomers from the rigid ("hard") and flexible ("soft") portions provides an additional means (besides the proportion of each block) to manipulate the overall properties of the polymer, as taught by Galleguillos. Further, it is well within the skill of ordinary artisan to select the appropriate properties of a copolymer for a given formulation. Therefore if an artisan wanted to produce a polymer with both high flexibility and shine (i.e. gloss) qualities, one would have been motivated to arrange the



Art Unit: 1611

rigid and flexible polymer blocks of Mougin such that they were connected by an intermediate block as taught by Galleguillos. It is reasonable that a block comprising monomers from each of a rigid ("hard") and flexible ("soft") block will have a  $T_g$  between these two extremes, as would be recognized by the ordinary artisan. Thus, the combination of Mougin and Galleguillos renders claim 85 obvious.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, in the absence of evidence to the contrary, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

**Claims 89-94, 99-110, 129-135, 151, and 154-159 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mougin as applied to claims 78 and 84 above, and further in view of Galleguillos (U.S. 6,410,005; Issued Jun. 25, 2002) and GUILLON (U.S. 4,425,326; Issued Jan. 10, 1984).**

11. The teachings of Mougin and Galleguillos are presented *supra*. Mougin teaches the use of preferred monomers methyl methacrylate (elected species) (paragraphs [0070] and [0082]) and methyl acrylate (elected species). It is noted that the glass

Art Unit: 1611

transition temperature ( $T_g$ ) of homopolymeric methyl methacrylate is approximately 115 °C and the  $T_g$  of homopolymeric methyl acrylate is 10 °C. However, Mougin does not embody the use of these two species together with sufficient specificity to be anticipatory. Nonetheless, the ordinary artisan would be motivated to select these two components since they were known in the art to be preferred components of glossy nail varnishes.

12. For example, Guillon discloses nail varnish compositions featuring a copolymer that comprises at least one methacrylate monomer and at least one acrylate monomer (abstract). Guillon teaches that the nail varnishes have good stability, adhesion, and gloss (col. 1, lines 4-7; Examples A, C, and F). Guillon teaches that these monomers are preferred to replace nitrocellulose in nail varnishes since nitrocellulose compositions are brittle and have poor nail adhesion (col. 1, lines 32-35). Guillon teaches the use of methyl methacrylate and methyl acrylate (col. 3, lines 35-41; claims 7 and 8).

13. In light of these teachings, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to select methyl methacrylate (which is taught by Mougin as a preferred monomer) and methyl acrylate (which is also taught by Mougin), to provide a suitable polymer for a nail varnish composition. One would have been motivated to do so since these components were well-known in the art to produce copolymers useful in glossy nail varnish compositions. One would have had a high expectation of success in doing so since Mougin teaches the use of these monomer components for the very same reason. Thus, claims 89-94, 99-102, 105-108 are obvious over Mougin, Galleguillos, and Guillon.

Art Unit: 1611

14. Mougin teaches that the portion of the rigid block (having a  $T_g$  greater than 20 °C) is from 10% to 60%, and the portion of the flexible block (having a  $T_g$  greater than 20 °C) is from 40% to 90%, rendering claims 103, 104, 109, and 110 obvious.

15. Regarding the limitation of an additional monomer, Mougin provides for the inclusion of additional monomers in the teaching that the blocks may consist of one *or more* different monomers (i.e. they may be homopolymers or random or alternating copolymers) and the blocks used in the polyblock configurations may comprise the same or different polymers (paragraphs [0038] and [0043]). Therefore, it would be *prima facie* obvious to an ordinary artisan to use any combination of these monomers as defined by the teachings of Mougin. Mougin teaches the use of acrylic acid as a monomer component (paragraph [0069]; claim 3). Additionally, Guillon teaches copolymers comprising acrylic acid, methyl methacrylate, and methyl acrylate as monomer components (claims 6, 7, and 8). Thus, acrylic acid would be an obvious choice for a skilled artisan wishing to prepare the glossy nail varnish composition of Mougin using an additional monomer for the block(s) as suggested by Mougin and known in the art. Thus, claims 129-134 are rendered obvious.

16. While Mougin provides for and teaches the use of an additional monomer(s) in the copolymers of the composition, Mougin does not disclose suitable weight % ranges for this component. However, Guillon teaches that the polar monomer (which may be acrylic acid) is present in a weight % of 5-30% (col. 2, lines 58-64). Thus, it would be *prima facie* obvious to the ordinary artisan to incorporate the additional monomer taught by Mougin in this amount, rendering claim 135 obvious.

Art Unit: 1611

17. Regarding claim 151, Mougin does not disclose a suitable weight % range in which the solvent component can be included. Mougin exemplifies one embodiment having 75% weight of the solvent (Example 4). In this example, the composition contains only the polymer and the solvent. Mougin teaches that the concentration of the copolymers in the compositions depends on several factors, but the concentration can vary from 1-99% by weight, preferably 7-40% by weight (paragraph [0101]). Thus, it would be prima facie obvious for one to add from 20-60% by weight solvent based on the amount of copolymer in the nail varnish compositions per the teachings of Mougin, and claim 151 is rendered obvious.

18. Mougin teaches the use of one or more plasticizers (paragraph [0121]) but does not provide weight % ranges for this component. Guillon teaches the use of plasticizers in amounts from 0.2 to 10% by weight (col. 4, lines 49-52), rendering claims 154 and 155 obvious.

19. Regarding claims 156-159, Mougin does not disclose the mean gloss of the compositions. However, it is noted that Mougin teaches monomers for use in the blocks of the copolymer that are identical to those claimed in the instant application (paragraphs [0047]-[0097]). Since the nail varnish compositions of Mougin are glossy and provide high transfer resistance (i.e. staying power and wear resistance), just as those in the instant specification, it is reasonable that the cosmetic compositions taught by Mougin (e.g. Example 4) would meet the limitations of mean gloss and transfer index if measured under the highly specialized conditions required in the instant application to measure "mean gloss". The compositions of Mougin are taught in a preferred

Art Unit: 1611

embodiment as glossy nail varnishes (e.g. example 4), which are typically prepared for the very purpose of having a glossy or shiny finish, as is evident from similar teaching in the prior art. For example, Guillon teaches that the main characteristics that nail varnishes must possess include a good gloss (col. 1, lines 4-16). Thus, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to formulate the copolymer nail varnish of Mougin, to provide a highly glossy finish as was typical in the art. Claims 156-159 are obvious over the prior art.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, in the absence of evidence to the contrary, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1611

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

U.S. Patent Application No. 10/529,266

Claims 78-86, 88-94, 98-110, 129-135, and 148-159 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 77-164 of copending Application No. 10/529,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '266 claims renders obvious that of the instant claims. The difference between the two claim sets is that the '266 claims recite that the mean gloss of the block polymer is greater than or equal to 30 out of 100. However, the mean gloss would be optimized by the skilled artisan preparing makeup products comprising the instantly claimed polymers depending on the intended use of the makeup. Since each application recites the same monomer components and architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the '266 application would meet the instant limitations and vice versa. It is noted that '266 claim 110 recites the elected species of methyl methacrylate, claim 113 encompasses the instantly elected species of methyl acrylate, and claim 154 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '266 claims.

Art Unit: 1611

As set forth above, claims 78-86, 88-94, 98-110, 129-135, and 148-159 are directed to an invention not patentably distinct from claims 77-164 of commonly assigned 10/528,266. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/529,266, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

U.S. Patent Application No. 10/528,698

Claims 78-86, 88-94, 98-110, 129-135, and 148-159 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 65-136 of copending Application No. 10/528,698. Although the conflicting claims are not identical, they are not patentably distinct from each other

Art Unit: 1611

because the scope of the '698 claims renders obvious that of the instant claims. The difference between the two claim sets is that the '698 claims are drawn to a lip makeup composition and do not recite a mean gloss of the block polymer. However, the mean gloss would be optimized by the skilled artisan preparing makeup products comprising the instantly claimed polymers depending on the intended use of the makeup. Since each application recites the same monomer components and architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the '698 application would meet the instant limitations and vice versa. It is noted that '698 claim 96 recites the elected species of methyl methacrylate, claim 100 encompasses the instantly elected species of methyl acrylate, and claim 110 recites acrylic acid, the elected species for the additional monomer. Furthermore, the use of the polymer for a nail varnish or a lipstick is an obvious variation as such components are routinely used in different forms of cosmetics throughout the art. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '698 claims.

As set forth above, claims 78-86, 88-94, 98-110, 129-135, and 148-159 are directed to an invention not patentably distinct from claims 78-159 of commonly assigned 10/528,698. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/528,698, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly



Art Unit: 1611

assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

U.S. Patent Application No. 10/529,264

Claims 78-86, 88-94, 98-110, 129-135, and 148-159 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-56 of copending Application No. 10/529,264. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '264 claims renders obvious that of the instant claims. The difference between the two claim sets is that the '264 claims do not recite a mean gloss. However, the mean gloss would be optimized by the skilled artisan preparing lip or eye makeup products comprising the instantly claimed polymers. Furthermore, since the mean gloss is an inherent property of a given polymer and since each application recites the same monomer components and polymer architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the '264

Art Unit: 1611

application would meet the mean gloss limitations and vice versa. It is noted that '264 claim 23 recites the elected species of methyl methacrylate, claim 26 encompasses the instantly elected species of methyl acrylate, and claim 36 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '264 claims.

As set forth above, claims 78-86, 88-94, 98-110, 129-135, and 148-159 are directed to an invention not patentably distinct from claims 1-56 of commonly assigned 10/529,264. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/529,264, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon

Art Unit: 1611

the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

U.S. Patent Application No. 10/529,218

Claims 78-86, 88-94, 98-110, 129-135, and 148-159 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 80-165 of copending Application No. 10/529,218. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '218 claims anticipates or renders obvious that of the instant claims. The difference between the two claim sets is that the '218 claims recite that the composition has a mean gloss of greater than or equal to 30 out of 100. However, the mean gloss would be optimized by the skilled artisan preparing makeup products comprising the instantly claimed polymers. Thus, it would be obvious to an ordinary artisan to optimize the gloss of the cosmetic formulation. Since each application recites the same monomer components and architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the instant application would meet the '218 limitation and vice versa. It is noted that '218 claim 91 recites the elected species of methyl methacrylate, claim 94 encompasses the elected species of methyl acrylate, and claim 108 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '218 claims.

Art Unit: 1611

As set forth above, claims 78-86, 88-94, 98-110, 129-135, and 148-159 are directed to an invention not patentably distinct from claims 80-165 of commonly assigned 10/529,218. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/529,218, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

U.S. Patent Application No. 11/086,906

Claims 78-86, 88-94, 98-110, 129-135, and 148-159 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-96 of copending Application No. 11/086,906. Although the conflicting claims are not identical, they are not patentably distinct from each other

Art Unit: 1611

because the scope of the '906 claims renders obvious that of the instant claims. The difference between the two claim sets is that the '906 claims recite that the film exhibits a water uptake of less than or equal to 10% and do not recite a mean gloss of the block polymer. However, the mean gloss would be optimized by the skilled artisan preparing makeup products comprising the instantly claimed polymers depending on the intended use of the makeup. Further, since each application recites the same monomer components and architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the '906 application would meet the instant limitations and vice versa. It is noted that '906 claim 9 recites the elected species of methyl methacrylate, claim 12 encompasses the instantly elected species of methyl acrylate, and claim 51 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '906 claims.

As set forth above, claims 78-86, 88-94, 98-110, 129-135, and 148-159 are directed to an invention not patentably distinct from claims 1-96 of commonly assigned 11/086,906. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 11/086,906, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was

Art Unit: 1611

made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

### ***Conclusion***

No claims are currently allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Orwig whose telephone number is (571)270-5869. The examiner can normally be reached Monday-Friday 7:00 am-4:00 pm (with alternate Fridays off). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached Monday-Friday 8:00 am-5:00 pm at (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KSO

/David J Blanchard/  
Primary Examiner, Art Unit 1643